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10/730,228	12/08/2003	Ronald P. Akialis JR.	200901561-1	2495
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EXAMINER JOHNSON, GREGORY L.				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
ipa.mail@hp.com
laura.m.clark@hp.com

Office Action Summary

Application No.

10/730,228

Applicant(s)

AKIALIS ET AL.

Examiner

Gregory Johnson

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to the appeal brief filed April 23, 2010.

Status of Claims

2. Claims 1-30 are as previously presented and pending.

Response to Arguments

3. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Regarding claim 1, the phrase "if the payment is authorized" renders the claim as being unclear because the "sending" step as been interpreted as being optional. This is based on an interpretation of "if the payment is not authorized", resulting in the step not being performed. For examination purposes, the Examiner has interpreted that the payment has been authorized. Appropriate correction is required (i.e. positive recitation) to establish patentable weight for the step/limitation.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claims 1-4 and 12-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez et al., Pub. No. 2002/0194138 (hereinafter "Dominguez"), in view of Putta et al., Pub. No. 2001/0032192 (hereinafter "Putta") and Kolling et al., Pat. No. 5,963,925 (hereinafter "Kolling").

As to claim 1, Dominguez discloses a method of authorizing one or more bill payments, the method comprising:

- receiving, at an authorization system that includes at least one computer, information entered by a consumer and sent by a biller through a network (\S 0059-0060, \S 0067-0068 and Figs. 1 and 4; discusses and illustrates a cardholder, a transaction, a merchant and a process for authorizing the transaction), wherein the information identifies:

- the consumer (§0050; via cardholder name),
- an amount to be paid (§0066; via payment amount),
- an account to be used to make a payment (§0066-0067; via card account number);
- determining whether the payment should be authorized (§0068; via the issuer financial institution will either authorize or decline the transaction);
- transmitting, through the network to a website of the biller, authorization information including whether to authorize the payment or refuse authorization of the payment (§0068; via the issuer then returns the authorization response via the payment network to the merchant).

Dominguez does not disclose the following element:

- sending, from the authorization system, an electronic notification directly to the consumer that the payment has been authorized, if the payment has been authorized.

However, Putta teaches a system and method for facilitating access to financial instruments such as credit and debit card accounts, checking accounts, bank accounts and the like. Putta teaches the use of an authorization module that receives payment requests for authorization from merchants, based on a customer deciding to make a payment. Putta also teaches that if the customer's preferences (i.e. user-modifiable preference conditions for their account) indicated that the customer should be notified upon a successful authorization, the customer is notified through notification interface

400 (e.g. to web browsers and wireless devices). [See ¶0022, ¶0049, ¶0054-0061, ¶0095 and Figs. 1-2 and 6].

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Putta within Dominguez for the motivation to provide flexible methods of processing transactions and payments based on existing credit card processing infrastructure while requiring minimal changes (¶0021).

Additional, Dominguez teaches systems and methods for authenticating the identity of account holders during online transactions, in which, an authentication service allows a card issuer to verify a cardholder's identity using a variety of authentication methods, such as the use of passwords (Abstract and ¶0002). And Putta teaches methods and apparatus for processing transactions of financial instruments such as credit cards, and more specifically for improving the security, flexibility and privacy of such transactions (¶0002).

Therefore, it also would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include in the online account authentication service as taught by Dominguez, the notification methods as taught by Putta, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143, Rational (A).

Neither Dominguez nor Putta discloses or teaches the following elements (as interpreted, the elements are directed to formatting of an electronic message):

- wherein the authorization information is formatted to appear as originating from the biller and in a predefined format specified by the biller (e.g. logos, font characteristics, etc); and
- wherein the electronic notification is formatted to appear as originating from the biller and in a predefined format (e.g. logos, font characteristics, etc) specified by the biller.

However, Kolling teaches an electronic statement presentment (ESP) system that replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery. Electronic statements have the same look as paper statements as well as including video, audio, graphics, and custom enclosures. Kolling teaches the use of templates in generating an electronic statement containing any information, format or logo that the biller desires to send to the consumer. This allows a biller to continue using a similar format and style such as is presented on paper statements to maintain the same "look and feel" for the consumer (Abstract; col.4, lines 15-29; col.6, lines 1-24; col.16, line 45 thru col.17, line 67; and col. 19, lines 7-13).

Dominguez teaches a method that includes transmitting authorization information and Putta teaches methods for transmitting notifications. Both types of communication (i.e. authorization or notification) would require electronic messages to be formatted based on some pre-defined scheme. Kolling teaches a method in which an electronic message can be formatted based upon a format desired by the biller.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to use templates for customizing the format of electronic messages based on a biller's pre-defined scheme as taught by Kolling, since the claimed invention is simply a substitution of one known element for another (i.e. formatting a notification and/or an authorization vs. formatting a statement), and one of ordinary skill in that art would have recognized that the results of the substitution would be predictable. See MPEP 2143, Rational (B).

In addition, the known work in the field of bill distribution/payments (e.g. customized formats for electronic documents/messages to maintain a "look and feel" of a biller's non-electronic messages) could have prompted variations of it for use in either the same field or a different one based on design incentives or other market forces, and the variations would have been predictable to one of ordinary skill in the art. See MPEP 2143, Rational (F).

As to claim 2, neither Dominguez nor Putta discloses or teaches the following limitations; however Kolling teaches the limitations:

- storing format information for each of a plurality of billers (Abstract and claim 54; via template library serves as a central repository of templates for said plurality of billers); and
- retrieving format information for a biller to whom the authorization information is sent (Abstract and claim 54; via transmitting said template from said template library to said generation workstation).

In regards to "formatting the electronic notification based on the retrieved format information", Putta teaches a Programmable Payment network can send information regarding recent authorizations or violations made on the customer's accounts, to the customer. A customer can thus get feedback about his charges, *without waiting for the monthly statement* or explicitly trying to get his information. This notification can be communicated to the customer via a communication media such as electronic mail (¶0123). And Kolling teaches using templates to generate (i.e. format) *electronic statements* (Abstract and claim 54).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to use templates for customizing the format of electronic messages sent to a consumer as taught by Kolling, since the claimed invention is simply a substitution of one known element for another (i.e. formatting a statement vs. formatting a notification), and one of ordinary skill in that art would have recognized that the results of the substitution would be predictable. See MPEP 2143, Rational (B).

In addition, the known work in the field of bill distribution/payments (e.g. customized formats for electronic documents/messages) could have prompted variations of it for use in either the same field or a different one based on design incentives or other market forces, and the variations would have been predictable to one of ordinary skill in the art. See MPEP 2143, Rational (F).

As to claim 3, Dominguez does not disclose the following limitation; however Putta teaches the limitation:

- wherein the received information includes an e-mail address for the consumer, and wherein sending the electronic notification includes sending the electronic notification in the form of an e-mail directly to the consumer through the network (§0123; via notification can be communicated to the customer via a communication media such as electronic mail).

Refer to the motivation, as recited in the rejection of claim 1 above, for the rational to include the teachings of Putta within Dominguez.

As to claim 4, Dominguez discloses the following limitations;

- wherein determining whether the payment should be authorized includes at least one of determining whether the payment will exceed the credit limit of the consumer's credit card, determining whether the payment will exceed the credit limit of the consumer's debit card, or validating the consumer's bank account (§0050 and §0053; via cardholder authentication information includes information such card account number and account balance; and verify the card account status).

As to claim 12, Dominguez discloses the following limitation:

- receiving, from the biller, a plurality of accumulated payments to be authorized in a batch by means of a function call (e.g. authorization messages can be batched and sent in a group at a later time; §0068).

As to claim 13, Dominguez discloses a method of authorizing one or more bill payments, the method comprising:

- a credit card number or a debit card number (§0066; via card account number),
- a verification code for the credit card number or the debit card number (§0053 and §0068; via cardholder verification value 2 (CVV2)); and
- determining whether the payment should be authorized based at least in part on whether the verification code is correct (§0053 and §0068; which discusses verifying the Cardholder Verification Value 2 (CVV2) and the issuer financial institution will either authorize or decline the transaction).

The remaining elements of claim 13 are equivalent to the elements of claim 1; see the rejections of claim 1 above.

As to claim 14, Dominguez discloses a method of authorizing one or more bill payments, the method comprising:

- editing the information sent by the biller (e.g. checking incoming data for various parameters) and returning edit failure information to the biller if editing fails (§0068; via the issuer financial institution processing of the authorization transaction and the *use of a flag indicating if the cardholder was successfully authenticated*, account information, digital signatures, a cardholder verification value 2, card authentication verification value (CAVV), an offline PIN authenticated by chip card EMV cryptogram, and

the necessary fields to provide the merchant with guaranteed payment);

and

- if the editing does not fail, determining whether the payment should be authorized at least partially based on whether the verification code is correct (§0068; via the issuer financial institution will either authorize or decline the transaction).

Dominguez does not explicitly disclose "returning edit failure information to the consumer if editing fails."

However, Putta teaches a system and method for facilitating access to financial instruments such as credit and debit card accounts, checking accounts, bank accounts and the like. Putta teaches the use of an authorization module that performs various checks to determine whether or not the authorization request should be rejected. Putta teaches that if any of the checks fail, the authorization request is rejected. The rejection is sent back to the merchant bank. In addition, based on customer's preferences, a customer may be notified of the rejection and the reason for it (§0088-0096).

Refer to the motivation, as recited in the rejection of claim 1 above, for the rationale to include the teachings of Putta within Dominguez.

The remaining elements of claim 14 are equivalent to the elements of claims 1 and 13; see the rejections of claims 1 and 13 above.

As to claim 15, Dominguez discloses a method of authorizing one or more bill payments (Abstract); Dominguez does not disclose the following limitations; however Kolling teaches the limitations:

- storing, in connection with the authorization system, format information for each of a plurality of billers (Abstract and claim 54; via template library serves as a central repository of templates for said plurality of billers); and
- retrieving format information for the biller to whom the authorization information is sent (Abstract and claim 54; via transmitting said template from said template library to said generation workstation).

In regards to "formatting the electronic notification in the format of the biller to whom the authorization information is sent", Putta teaches a Programmable Payment network can send information regarding recent authorizations or violations made on the customer's accounts, to the customer. A customer can thus get feedback about his charges, *without waiting for the monthly statement* or explicitly trying to get his information. This notification can be communicated to the customer via a communication media such as electronic mail. And Kolling teaches using templates to generate (i.e. format) *electronic messages*.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to use templates for customizing the format of electronic messages sent to a consumer as taught by Kolling, since the claimed invention is simply a substitution of one known element for another (i.e. formatting a statement vs.

formatting a notification), and one of ordinary skill in that art would have recognized that the results of the substitution would be predictable. See MPEP 2143, Rational (B).

In addition, the known work in the field of bill distribution/payments (e.g. customized formats for electronic documents/messages) could have prompted variations of it for use in either the same field or a different one based on design incentives or other market forces, and the variations would have been predictable to one of ordinary skill in the art. See MPEP 2143, Rational (F).

The remaining elements of claim 15 are equivalent to the elements of claims 1 and 13; see the rejections of claims 1 and 13 above.

As to claim 16, Dominguez discloses a method of authorizing one or more bill payments, the method comprising:

- assigning an identification number for each transaction for a given the biller (¶0068 and ¶0103; via the payment response message contains a card authorization verification value (CAVV), to inform the merchant that the cardholder has been authenticated); and
- transmitting the identification number to the biller (¶0103).

The remaining elements of claim 16 are equivalent to the elements of claims 1, 13, 14 and 15; see the rejections of claims 1, 13, 14 and 15 above.

As to claim 17, Dominguez discloses the following limitation:

- assigning an identification number for each transaction for each biller of a plurality of billers (0068 and ¶0103; the payment response message

contains a card authorization verification value (CAVV), to inform the merchant that the cardholder has been authenticated);

- storing the identification numbers (§0009, §0041, §0066 and §0103; via storing signed which contain information that verifies which transactions were authenticated and provides additional information during dispute resolution processes); and
- transmitting the identification numbers associated with a given one of the billers to the biller in a report of transactions associated with the biller during a specified period of time (§0103 and §0244-0245; via billing reports).

10. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez, Putta and Kolling as applied to claim 1 above, and further in view of Ensel et al., Pat. No. 6,493,685 (hereinafter "Ensel").

As to claim 5, neither Dominguez, Putta nor Kolling discloses or teaches the following limitations:

- wherein determining whether the payment should be authorized includes, in a request for payment from a bank account;
- communicating authorization;
- submitting the transaction for bank clearance after authorization;
- and communicating clearance failure to the biller if and when clearance failure is received.

However, Ensel teaches that in a method for an electronic account presentation and response system there is a process for accepting a payment from a bank account. Ensel teaches that the system generates an ACH debit to the customer to debit the account identified by the customer, and also credits the biller in the amount debited from the customer. If later the ACH does not clear, after two attempts, the system will debit the account of the biller. At this time, it is the responsibility of the biller to start a collection process against the customer (column 17, line 41 thru column 18, line 18).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Ensel within the combination of Dominguez, Putta and Kolling for the motivation to provide a method that ensures privacy and security for billing and payment information for use in biller's systems and operations environments (col. 3, line 20-39).

As to claim 6, Dominguez discloses the following limitation:

- accumulating a plurality of payment requests over a period of time; and submitting the accumulated plurality of payment requests for clearance in a batch (e.g. authorization messages can be batched and sent in a group at a later time; ¶0068).

11. Claims 7-8, 10 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez, Putta and Kolling as applied to claims 1 and 13-16 above, and further in view of Byrne et al., Pub. No. 2003/0229590 (hereinafter "Byrne").

As to claims 7-8, 10 and 26-29, neither Dominguez, Putta nor Kolling discloses or teaches the following limitations; however, Byrne teaches the limitations:

- pre-authorizing a given consumer and a given credit card or debit card based on cardholder information; and sending the pre-authorization information to the biller prior to receipt of a specific request for authorization of a specific payment charged to said card from the given consumer to allow a biller to determine the validity of the card prior to proceeding with a transaction (§0045);
- reversing a payment authorization at a request of the biller, wherein the request of the biller is provided prior to an end of a business day, and wherein the authorization was given during the same business day; and notifying at least one bank or credit card organization to whom the payment authorization was communicated (e.g. credit or void; §0041-0042 and §0105);
- receiving from the biller at least one of restrict or unrestrict instructions for an account of one or more customers; storing the instructions in association with the authorization system; and retrieving and implementing the instructions upon receipt of a payment request for the account of the one or more customers (e.g., reject orders from certain e-mail accounts or credit cards; §0149);
- first pre-authorizing a given customer and a given credit card or debit card based on cardholder information (§0045); and sending information of the

pre-authorization to the biller prior to receipt of a specific request for authorization of a specific payment charged to said card from a consumer to allow a biller to determine the validity of the card prior to proceeding with a transaction (§10045);

- first pre-authorizing a given customer and a given credit card or debit card based on cardholder information; and sending information of the pre-authorization to the biller prior to receipt of a specific request for authorization of a specific payment charged to the credit card or the debit card so as to allow the biller to determine a validity of the credit card or the debit card prior to proceeding with a transaction (§10045).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Byrne within Dominguez for the motivation to provide a payment platform that can incorporate new technologies to provide a secure, reliable and flexible payment transaction processing solution for financial organizations and the sellers that they serve to reduce risk and improve profitability for those financial organizations that adopt it (§10009).

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez, Putta and Kolling as applied to claim 1 above, and further in view of Byrne and Jamison et al., Pub. No. 2003/0191711 (hereinafter "Jamison").

As to claim 9, neither Dominguez, Putta nor Kolling discloses or teaches the following limitations; however Byrne teaches the following limitations:

- storing, at said authorization system, basic billing information for each of a plurality of customers of a biller (e.g. customer's credit card information is stored at the integrated payment system 50; ¶0028 and ¶0045);
- providing the biller with access to the billing information for each of the customers (¶0045); and
- allowing the biller to modify the accessed billing information directly (¶0045).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Byrne within Dominguez for the motivation to provide a payment platform that can incorporate new technologies to provide a secure, reliable and flexible payment transaction processing solution for financial organizations and the sellers that they serve to reduce risk and improve profitability for those financial organizations that adopt it (¶0009).

Neither Dominguez, Putta, Kolling nor Byrne discloses or teaches the following limitation; however Jamison teaches the limitation:

- giving a customer access to customer's associated billing information (e.g. customer can modify the information contained in the payment account; ¶0212).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Jamison within the Dominguez and Byrne combination for the motivation to provide a technique

for paying bills to any biller website that permits online payment of a bill by an electronic bill presentment and payment ("EBPP") systems (§§0003 and §§0025).

13. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez, Putta and Kolling as applied to claim 1 above, and further in view of Crea et al., Pub. No. 2004/0210521 (hereinafter "Crea").

As to claim 11, neither Dominguez, Putta nor Kolling discloses or teachings the following limitation; however, Crea teaches the limitation:

- providing a preliminary calculation of fees to the consumer in response to supplying the amount and a means of payment (e.g. transaction fee) (§§0021 and §§0035; which discusses a transaction processor charging a to a consumer and a payment confirmation screen displaying fees that may be charged).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Crea within the combination of Dominguez, Putta and Kolling for the motivation to provide an additional element used in processing of payments from a consumer to a payee (§§0002 and §§0004).

14. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez, in view of Putta, Kolling and Mersky et al., Pat. No. 6,119,106 (hereinafter "Mersky").

As to claim 18, Dominguez discloses a method of authorizing one or more bill payments, the method comprising:

- receiving, at an authorization system that includes at least one computer, information entered by a consumer and sent by a biller through the worldwide web (§0059-0060, §0067-0068 and Figs. 1 and 4; discusses and illustrates a cardholder, a transaction, a merchant and a process for authorizing the transaction), wherein the information identifies:
- a payor (§0050; via cardholder name),
- an amount to be paid (§0066; via payment amount),
- an account to be used to make a payment (§0066-0067; via card account number);
- determining whether the payment should be authorized (§0068; via the issuer financial institution will either authorize or decline the transaction); and
- transmitting, through the worldwide web to a website of the biller, authorization information including whether to authorize the payment or refuse authorization of the payment (§0068; via the issuer then returns the authorization response via the payment network to the merchant).

Dominguez does not disclose the following element:

- sending, from the authorization system, an electronic notification to the payor that the payment has been authorized.

However, Putta teaches a system and method for facilitating access to financial instruments such as credit and debit card accounts, checking accounts, bank accounts and the like. Putta teaches the use of an authorization module that receives payment requests for authorization from merchants, based on a customer deciding to make a payment. Putta also teaches that if customer preferences (i.e. user-modifiable preference conditions for their account) indicated that the customer should be notified upon a successful authorization, the customer is notified through notification interface 400 (e.g. to web browsers and wireless devices). [See ¶0022, ¶0049, ¶0054-0061, ¶0095 and Figs. 1-2 and 6].

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Putta within Dominguez for the motivation to provide flexible methods of processing transactions and payments based on existing credit card processing infrastructure while requiring minimal changes (¶0021).

Neither Dominguez nor Putta discloses or teaches the following elements:

- wherein the authorization information is formatted to appear as originating from the biller and in a predefined format (e.g. logos, font characteristics, etc) specified by the biller; and

- wherein the electronic notification is formatted to appear as originating from the biller and in a predefined format (e.g. logos, font characteristics, etc) specified by the biller.

However, Kolling teaches an electronic statement presentment (ESP) system that replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery. Electronic statements have the same look as paper statements as well as including video, audio, graphics, and custom enclosures. Kolling teaches the use of templates in generating an electronic statement containing any information, format or logo that the biller desires to send to the consumer. This allows a biller to continue using a similar format and style such as is presented on paper statements to maintain the same "look and feel" for the consumer (Abstract; col.4, lines 15-29; col.6, lines 1-24; col.16, line 45 thru col.17, line 67; and col. 19, lines 7-13).

Dominguez teaches a method that includes transmitting authorization information and Putta teaches methods for transmitting notifications. Both types of communication (i.e. authorization or notification) would require electronic messages to be formatted based on some pre-defined scheme. Kolling teaches a method in which an electronic message can be formatted based upon a format desired by the biller.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to use templates for customizing the format of electronic messages based on a biller's pre-defined scheme as taught by Kolling, since the claimed invention is simply a substitution of one known element for another (i.e. formatting a notification and/or an authorization vs. formatting a statement), and one of

ordinary skill in that art would have recognized that the results of the substitution would be predictable. See MPEP 2143, Rational (B).

In addition, the known work in the field of bill distribution/payments (e.g. customized formats for electronic documents/messages to maintain a "look and feel" of a biller's non-electronic messages) could have prompted variations of it for use in either the same field or a different one based on design incentives or other market forces, and the variations would have been predictable to one of ordinary skill in the art. See MPEP 2143, Rational (F).

Dominguez also does not disclose the following elements:

- one or more billing personnel responsible for bills; and
- reporting the information identifying the billing personnel to the biller when reporting authorization results.

However, Mersky teaches a method and apparatus (i.e. system) for facilitating customer payments to creditors from a remote site, where transaction files include a plurality of records, with each having information pertaining to a particular transaction. Mersky teaches that the information includes an agent number (column 9, lines 50-67).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Mersky within Byrne for the motivation of creating reports of the daily transactions, for each creditor (e.g. biller), that include all details for each transaction, including the agent responsible for enter the payment into the system (col. 10, lines 1-67).

As to claim 19, Dominguez discloses a method of authorizing one or more bill payments, the method comprising:

- receiving, at an authorization system that includes at least one computer, information entered by a consumer and sent by a biller through the worldwide web (§§0059-0060, §0067-0068 and Figs. 1 and 4; discusses and illustrates a cardholder, a transaction, a merchant and a process for authorizing the transaction), wherein the information identifies:
- the consumer (§0050; via cardholder name),
- an amount to be paid (§0066; via payment amount),
- an account to be used to make a payment (§0066-0067; via card account number);
- determining whether the payment should be authorized (§0068; via the issuer financial institution will either authorize or decline the transaction);
- transmitting, through the worldwide web to a website of the biller, authorization information including whether to authorize the payment or refuse authorization of the payment (§0068; via the issuer then returns the authorization response via the payment network to the merchant);
- determining a correctness of the verification code of a credit card or debit card used in the payment (§0053 and §0068; via verifying the Cardholder Verification Value 2 (CVV2));
- assigning an identification number for each transaction for the biller (§0068 and §0103; via the payment response message contains a card

authorization verification value (CAVV), to inform the merchant that the cardholder has been authenticated); and

- transmitting the identification number to the biller (§0103).

Dominguez discloses that the cardholder's account information includes the cardholder e-mail addresses; however Dominguez does not explicitly disclose the limitation:

- sending, by the authorization system, an e-mail to the payor that the payment has been authorized.

However, Putta teaches a system and method for facilitating access to financial instruments such as credit and debit card accounts, checking accounts, bank accounts and the like. Putta teaches the use of an authorization module that receives payment requests for authorization from merchants, based on a customer deciding to make a payment. Putta also teaches that if the customer preferences (i.e. user-modifiable preference conditions for their account) indicated that the customer should be notified upon a successful authorization, the customer is notified through notification interface 400; and notification can be communicated to the customer via a communication media such as electronic mail. [See §0022, §0049, §0054-0061, §0095, §0123 and Figs. 1-2 and 6].

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Putta within Dominguez for the motivation to provide flexible methods of processing transactions

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and payments based on existing credit card processing infrastructure while requiring minimal changes (§0021).

In addition, Dominguez teaches systems and methods for authenticating the identity of account holders during online transactions, in which, an authentication service allows a card issuer to verify a cardholder's identity using a variety of authentication methods, such as the use of passwords (Abstract and §0002). And Putta teaches methods and apparatus for processing transactions of financial instruments such as credit cards, and more specifically for improving the security, flexibility and privacy of such transactions (§0002).

Therefore, it also would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include in the online account authentication service as taught by Dominguez, the notification methods as taught by Putta, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143, Rational (A).

Dominguez discloses that the merchant may send an order confirmation message to the cardholder's browser; however, Dominguez does not disclose the following element:

- wherein the authorization information is formatted to appear as originating from the biller and in a predefined format (e.g. logos, font characteristics, etc) specified by the biller; and

- wherein the e-mail is formatted in a predefined format (e.g. logos, font characteristics, etc) and presented as originating from the biller.

However, Kolling teaches an electronic statement presentment (ESP) system that replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery. Electronic statements have the same look as paper statements as well as including video, audio, graphics, and custom enclosures. Kolling teaches the use of templates in generating an electronic statement containing any information, format or logo that the biller desires to send to the consumer. This allows a biller to continue using a similar format and style such as is presented on paper statements to maintain the same "look and feel" for the consumer (Abstract; col.4, lines 15-29; col.6, lines 1-24; col.16, line 45 thru col.17, line 67; and col. 19, lines 7-13).

Dominguez teaches a method that includes transmitting authorization information and Putta teaches methods for transmitting notifications. Both types of communication (i.e. authorization or notification) would require electronic messages to be formatted based on some pre-defined scheme. Kolling teaches a method in which an electronic message can be formatted based upon a format desired by the biller.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to use templates for customizing the format of electronic messages based on a biller's pre-defined scheme as taught by Kolling, since the claimed invention is simply a substitution of one known element for another (i.e. formatting a notification and/or an authorization vs. formatting a statement), and one of

ordinary skill in that art would have recognized that the results of the substitution would be predictable. See MPEP 2143, Rational (B).

In addition, the known work in the field of bill distribution/payments (e.g. customized formats for electronic documents/messages to maintain a "look and feel" of a biller's non-electronic messages) could have prompted variations of it for use in either the same field or a different one based on design incentives or other market forces, and the variations would have been predictable to one of ordinary skill in the art. See MPEP 2143, Rational (F).

Dominguez also does not disclose the following elements:

- determining an identify of billing personnel responsible for bills; and
- reporting to the biller an identity of the billing personnel with an authorization result.

However, Mersky teaches a method and apparatus (i.e. system) for facilitating customer payments to creditors from a remote site, where transaction files include a plurality of records, with each having information pertaining to a particular transaction. Mersky teaches that the information includes an agent number (column 9, lines 50-67).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Mersky within Byrne for the motivation of creating reports of the daily transactions, for each creditor (e.g. biller), that include all details for each transaction, including the agent responsible for enter the payment into the system (column 10, lines 1-67).

15. Claims 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez, in view of Kolling and Cook et al., Pat. No. 6,675,153 (hereinafter "Cook").

As to claim 20, Dominguez discloses a system for authorizing one or more bill payments, the system comprising:

- an authorization web server programmed for selective communication through a network with a plurality of billers' web servers (§§0035-0037 and Fig. 1; via issuer's authorization & settlement system);
- a programmed digital computer system linked to the authorization web server to obtain authorization information from a financial institution authorizing or rejecting a payment request received at a particular one of the billers' web servers from a payor's computer through the network, and to communicate authorization information to the particular biller's web server by the use of web services programming (§§0032-0043 and Figs. 1, 4, 6 and 10A; discusses and illustrates the centralized and distributed architectures of the online account authentication service);
- the programmed digital computer system being programmed to edit information (i.e. checking for the presence of various parameters; per pgs. 10-11 of specification) relating to the payment request received at the particular biller's web server from the payor's computer through the network (§§0065-0068; discusses verifying transaction information, such as a digital signature used to sign the payment receipt).

Dominguez does not disclose the following element:

- the programmed digital computer system being programmed to send, directly to the payor's computer originating the payment request, an e-mail containing the authorization information.

Cook teaches a method for electronic transaction authorization over a network in which a payment authorization system processes transactions between consumers (e.g. member 110) and merchants (col. 1, lines 9-11; and col. 10, line 66 thru col. 12, line 40). Cook also teaches that transaction authorization information is sent by secure E-mail to the consumer (col. 12, lines 38-40).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Cook within Dominguez for the motivation to provide a method that allows consumers to authorize transactions in a secure, private, and convenient manner for the purchase of goods and services over the Internet (col. 3, lines 16-26).

Dominguez also does not disclose the following elements:

- wherein the authorization information is formatted to appear as originating from the particular biller and in a predefined format specified by the particular biller;
- wherein said e-mail is formatted in a predefined format specified by the particular biller such that the e-mail appears to be generated by the particular biller.

However, Kolling teaches an electronic statement presentment (ESP) system that replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery. Electronic statements have the same look as paper statements as well as including video, audio, graphics, and custom enclosures. Kolling teaches the use of templates in generating an electronic statement containing any information, format or logo that the biller desires to send to the consumer. This allows a biller to continue using a similar format and style such as is presented on paper statements to maintain the same "look and feel" for the consumer (Abstract; col.4, lines 15-29; col.6, lines 1-24; col.16, line 45 thru col.17, line 67; and col. 19, lines 7-13).

Dominguez teaches a method that includes transmitting authorization information and Cook teaches methods for transmitting notifications. Both types of communication (i.e. authorization or notification) would require electronic messages to be formatted based on some pre-defined scheme. Kolling teaches a method in which an electronic message can be formatted based upon a format desired by the biller.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to use templates for customizing the format of electronic messages based on a biller's pre-defined scheme as taught by Kolling, since the claimed invention is simply a substitution of one known element for another (i.e. formatting a notification and/or an authorization vs. formatting a statement), and one of ordinary skill in that art would have recognized that the results of the substitution would be predictable. See MPEP 2143, Rational (B).

In addition, the known work in the field of bill distribution/payments (e.g. customized formats for electronic documents/messages to maintain a "look and feel" of a biller's non-electronic messages) could have prompted variations of it for use in either the same field or a different one based on design incentives or other market forces, and the variations would have been predictable to one of ordinary skill in the art. See MPEP 2143, Rational (F).

As to claim 24, Dominguez discloses the following limitation:

- wherein the computer system is programmed to demand that credit card or debit card verification codes be submitted with any credit card or debit card payment requests, and to use the verification codes with other credit card information to protect against fraud in obtaining authorization for card payments (§0053).

16. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez, Kolling and Cook as applied to claim 20 above, and further in view of Byrne.

As to claims 21-22, neither Dominguez, Kolling nor Cook discloses or teaches the following limitations; however, Byrne teaches the limitations:

- wherein said authorization information is sent to the payor's computer and the particular biller's web server substantially simultaneously (§0107; via complex schema that contains the URL to post transaction response information back to the merchant and for sending confirmation e-mails); and

- wherein information regarding a format desired for communications to the payor on behalf of the particular biller is stored and retrieved to format the e-mail sent to the payor in a format desired by the particular biller (§0092-0093 and Table 1).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Byrne within the combination of Dominguez, Kolling and Cook for the motivation to provide a payment platform that can incorporate new technologies to provide a secure, reliable and flexible payment transaction processing solution for financial organizations and the sellers that they serve to reduce risk and improve profitability for those financial organizations that adopt it (§0009).

17. Claims 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez, Cook and Kolling as applied to claim 20 above, and further in view of Mersky.

As to claims 23 and 25, neither Dominguez, Kolling nor Cook discloses or teaches the following limitations:

- wherein the computer system is programmed to apply a transaction number to each transaction for the particular biller, store the transaction numbers, and report the transaction numbers to the particular biller; and

- wherein the computer system is programmed to receive, store, and report to each biller an identity of billing personnel responsible for obtaining authorized payment.

However, Mersky teaches a method and apparatus (i.e. system) for facilitating customer payments to creditors from a remote site, where each transaction is assigned an identification number and for transactions involving an agent (i.e. billing personnel); the agent number is included in the transaction record, which is stored in a database. Mersky also teaches that the information related to each transaction is communicated to the biller (e.g. creditor; column 9, line 33 thru column 10, line 67; and column 12, lines 10-12). Mersky also teaches that the system receives, stores and reports to each biller (e.g. creditor) the identity of the billing personnel (e.g. agent) responsible for obtaining the payment authorized (column 9, line 33 thru column 10, line 67; and column 12, lines 10-12).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Mersky within the combination of Dominguez, Kolling and Cook for the motivation of creating and storing records for each transaction, of each creditor (e.g. biller), where the records contain a plurality details on the particular transaction (col. 9, line 33-67).

18. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dominguez, Putta, Kolling and Mersky as applied to claim 19 above, and further in view of Byrne.

As to claim 30, neither Dominguez, Putta, Kolling nor Mersky discloses or teaches the following limitation; however, Byrne teaches the limitation:

- first pre-authorizing a given customer and a given credit card or debit card based on cardholder information; and sending the pre-authorization information to the biller prior to receipt of a specific request for authorization of a specific payment charged to said card from a consumer to allow a biller to determine the validity of the card prior to proceeding with a transaction (§0045).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Byrne within Dominguez for the motivation to provide a payment platform that can incorporate new technologies to provide a secure, reliable and flexible payment transaction processing solution for financial organizations and the sellers that they serve to reduce risk and improve profitability for those financial organizations that adopt it (§0009).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Johnson whose telephone number is (571)272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory Johnson/
Examiner, Art Unit 3691